

**RESPONSE UNDER  
37 CFR 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 3722**

**REMARKS/ARGUMENTS**

This Amendment is submitted in response to the Final Office Action dated January 11, 2005. Claims 1-17 remain in this application for examination. Favorable reconsideration of the application is respectfully requested.

**1. Allowable Subject Matter**

Applicant gratefully acknowledges the indication of allowability of Claims 1-11 and 14-17.

**2. Rejection of Claims 12-13 under 35 U.S.C. 102(b)**

Claims 12 and 13 stand rejected under 35 U.S.C. 102(b) as being anticipated by Tsuda. The Office Action provides:

“Tsuda discloses all of the subject matter as set forth in the claims and is identical to the invention as broadly recited. Some of the claimed elements clearly disclosed by the reference are: a pocket (11) with a floor and walls positioned rearwardly from the front end of a body (9); wherein the pocket further includes a recess (not numbered).”

In response to Applicant's arguments submitted October 18, 2004, the Office Action further provides:

“In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the specifics of the cutting insert) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Tsuda does not disclose a holder adapted to hold a cutting insert having four sides as recited by applicant in claim 12, the examiner submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).”

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Initially, it is respectfully submitted that the features upon which applicant relies are in fact recited in the claim. Claim 12 provides as follows:

12. A toolholder for supporting a cutting insert having a core with four sides defining a quadrilateral shape and having diametrically opposing corners with **a pair of cutting portions having cutting tips extending from two diametrically opposing corners**, wherein the toolholder is comprised of:
- a) a body having a front end;
  - b) a pocket with a floor and walls positioned rearwardly from the front end of the body, wherein the pocket has a core region adapted to conform to and provide support to the insert core;
  - c) wherein two walls in the core region are adapted to conform to and provide support to two sides of the insert core;
  - d) wherein the floor in the core region is adapted to conform to and provide support to the insert core;
  - e) wherein the pocket further includes a recess extending rearwardly from the core region and of **sufficient area to encompass one cutting tip of the insert when the insert is mounted within the pocket**;
  - f) wherein the core region of the pocket terminates at the front end of the body such that when the insert is positioned within the pocket, one cutting tip extends beyond the front end of the toolholder while the other cutting tip is encompassed by the pocket recess.

As previously urged by Applicant, Tsuda neither teaches nor suggests a tool holder having a pocket with a recess for holding an insert having two cutting tips of sufficient area to encompass one cutting tip of the insert. Consequently, Tsuda cannot be an anticipatory reference because in order for a reference to be an anticipatory reference, the reference must disclose each and every element of the claimed invention.

In regard to the Office Action statement concerning recitation of intended use, the Office Action acknowledges that "[i]f the prior art structure is capable of performing the intended use, then it meets the claim." Applicant contends that the cited prior is not capable of performing the intended use. More particularly, the recess in the pocket of the toolholder of Tsuda is not of sufficient area to hold the front cutting edge (5). The Office Action has not established that Tsuda is capable of holding an insert having two cutting tips of sufficient area to encompass one cutting tip of the insert as claimed. Therefore, the Office Action has failed to meet the burden of establishing a *prima facie* case of anticipation.

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As previously urged, Tsuda appears to teach an indexable insert and holder. Specifically, a cutting insert (1) having a cutting edge (5) at the end of a stick shaped portion (7) projecting from a tool base. The insert is secured to a holder (9) within an insert pocket (11) of the holder. The insert taught by Tsuda has only one cutting portion (5). The pocket (11) of the toolholder taught by Tsuda is designed for holding such a one-sided cutting insert.

The present invention as expressed in Claim 12 is for a toolholder having a pocket for supporting a cutting insert. The cutting insert to be held in the aforementioned toolholder is specifically defined as having "a pair of cutting portions having cutting tips extending from two diametrically opposing corners." The pocket of the toolholder includes a recess "of sufficient area to encompass one cutting tip of the insert when the insert is mounted within the pocket." Tsuda neither teaches nor suggests a tool holder having a pocket with a recess for holding an insert having two cutting tips of sufficient area to encompass one cutting tip of the insert. The recess in the pocket of the toolholder of Tsuda clearly is not of sufficient area to hold the front cutting edge (5).

For at least the aforementioned reasons, Claim 12 is allowable over Tsuda. As Claim 13 depends from Claim 12, Claim 13 should be allowed over Tsuda for the same reasons. Withdrawal of the rejection is respectfully requested.

In view of the above remarks, it is believed that the application is in condition for allowance. Accordingly, an early Notice Of Allowance is respectfully requested.

Respectfully submitted,



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